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Paper No. 39

In re Application of
Randall A. Addington *et al*
Application No. 09/396,531
Filed: September 15, 1999
Attorney Docket No. 99-1001

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: DECISION ON PETITION
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This is a decision on the petition filed by facsimile transmission on June 26, 2003 by which petitioners that this application be removed from examination by personnel within or related to Group 3700. Petitioners also request that the Office action dated June 18, 2003 be removed and expunged in favor of a new action. The petition, having been filed under 37 CFR 1.181, does not require a fee and no fee has been charged.

The petition is granted-in-part.

With respect to the second grounds of relief, a review of the Office letter in question shows that it in fact contains improvident and improper comments regarding the familiarity of "applicant" with Office practice. There is no place for such commentary in an Office action, and it is agreed that the presence of such comments dictates that the Office letter dated June 18, 2003 be vacated and expunged from the record.

With respect to the first grounds of relief, a thorough review of the prosecution history of this application fails to reveal any bias or prejudice on the part of the examiner against petitioners or counsel. The examiner has consistently applied a primary reference, Fowble, and has not demonstrated that any prejudice against anyone prosecuting this application. Rather, the examiner has simply indicated that he feels that the claims are not patentable over this primary reference, alone and in combination with other prior art, and also in view of technical "non-prior art grounds." It is clear that both petitioners and the examiner each feel a certain degree of frustration over their respective inabilities to convince the other party of the correctness of their respective positions. However, the examiner's actions have been formulated in accordance with the provisions of MPEP §§ 706 and 707 and the subsections thereof, and have made use of "form paragraphs" as found therein. That counsel and petitioners disagree with the merits of these actions is no more indicative of bias on the part of the examiner (or any other personnel in Technology Center 3700) than the examiner's disagreement with petitioners' position is indicative of the degree of patent prosecution expertise possessed by petitioners and counsel.

This application is being forwarded to the Supervisory Patent Examiner (SPE) of Art Unit 3711 who will see that the following items are accomplished:

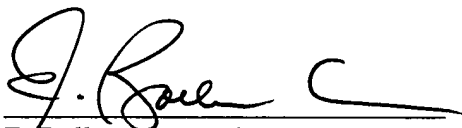
1. The Office letter dated June 18, 2003 will be vacated and expunged from the record. The contents entry for paper No. 33 will show that the action has been expunged, and the action will be physically removed from the file.
2. The SPE will discuss this application with the examiner, and will counsel the examiner with respect to the manner in which Office actions will be written without the inclusion of any sort of personal comments directed to either applicants or their counsel.

3. A new Office action containing the substantive matters set forth in the June 18, 2003, but omitting any personal comments directed to either applicants or their counsel will be promulgated, and will set a new three month shortened statutory period for reply.

4. The Notice of Appeal filed on September 17, 2003 will be entered. Counsel will have the option of filing a reply to the new Office letter, or pursuing the appeal. As the appeal was not necessary to forestall abandonment, because the June 18, 2003 Office letter has been vacated and expunged, petitioners will be entitled to a refund of the appeal fee in the event that an appeal is not perfected by petitioners.

After mailing of the new Office letter and entry of the Notice of Appeal, the application will be returned to storage in the Technology Center 3700 Central Files pending a reply to the Office letter.

PETITION GRANTED-IN-PART

A handwritten signature in dark ink, appearing to read 'E. Rollins-Cross', with a long horizontal flourish extending to the right.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

Joel I. Rosenblatt
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